

Appl No.: 10/649,288

Atty. Dkt.
PC-802**REMARKS/ARGUMENTS**

Favorable consideration of this application is respectfully requested. Applicant has amended claims 10, 13, 14, 16, 48, 52, 56-60, canceled claims 15, 17, 18. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks. Applicant gratefully appreciates the telephone interview with the Examiner Fletcher on October 17, 2006.

The interview discussed the previous office action and suggested amendment response. Applicant's claims are Applicants' claimed invention is directed to "pressurized water supply pipes", which was partially covered in previously submitted claims 13, 14 and 16, and are supported by at least pages 5-9, 31 of the subject specification. The claimed "piping system" covers the hot and cold water lines and sprinkler lines that are under pressure for delivering supply water throughout the buildings. As noted in the interview the Kamiya reference is directed to a system that must work with "drain pipes" and "wastewater" lines which are clearly NOT water delivery pipes under pressure. For this reason and the other remarks mentioned below, applicant believes the claims are now in allowable form. No new matter or new considerations are being raised by this amendment and response.

Applicant notes and acknowledges that the Examiner has removed the Kruse patent as prior art against the subject invention.

Applicant respectfully requests the amendment be entered and the application passed to allowance. Alternatively, applicant requests the subject amendment be entered and a new NONFINAL rejection be made since the previous office action was prematurely made FINAL. As noted below, applicant's previous amendment did NOT necessitate a new rejection should be made, and the previous office action is clearly in error since Reimelt was ALREADY cited by applicant and noted and acknowledged by the Examiner. Also, the Kruse patent which was cited by the examiner as being overcome also referenced the same Reimelt reference.

Applicants previous amendment response did not necessitate any "new grounds of rejection..." Since the claims merely repeated what was previously stated and the new independent claims 48 and 58 merely reduced and NOT added claimed features over previous sole independent claim 10. Thus, for at least these reasons the current office action is NOT a proper final rejection.

Claims 10-18 and 43-61 were rejected under sec. 103 as unpatentable by Kamiya '246 in view of Reimelt '913.

As noted above, Kamiya is restricted to "drain pipes" and "wastewater" lines which are clearly NOT water delivery pipes under pressure. Applicants' claimed invention is directed to "pressurized water supply pipes", which was partially covered in previously submitted claims 13, 14 and 16. Applicants specification refers to the invention primarily being useful for pressurized water supply pipes on pages 5-9, 31 which are primarily metal type pipes that are designed for pressurized water supply.

Kamiya describes and limits his invention to "horizontal" sections of a non-pressurized "drain pipe...", abstract, and only applies a "resin" coating. Kamiya only describes "horizontal" pipes and the figures appear to be top type views of those "horizontal" pipes, which do not include vertical and horizontal piping.

Appl No.: 10/649,288

Atty. Dkt.
PC-802

The Kamiya patent is restricted to non-pressurized "drain" pipes on a "horizontal" and would be incapable of working with "introducing a nonliquid cleaning agent that includes an abrasive medium into the generated air" into the pipes.

Kamiya states they use 2/3kg(4-9lbs) of air pressure force to coat their pipes, paragraphs 15, 17. Non-pressurized drain systems as described by Kamiya are not designed to be pressurized. By design, non pressurized drain lines cannot take more than low pressures. Eg: Uniform Plumbing Code 2002 Sec 712.3 test for open drain systems requires 5 pounds pressure.

Furthermore, Kamiya's requirement of "horizontal" usage would not work in a "multi-story" structure as claimed in subject independent claim 10, which would require vertical and horizontal piping.

Applicant notes that the Reimelt reference is no better than other references made of record. Applicant notes that the Reimelt patent 5,924,913 was previously cited by the Applicant and was filed under Information Disclosure Statement filed on December 22, 2005 and initialed by the subject examiner on Supplemental Form PTO 1449 that was mailed to the applicant in the previous office action mailed May 18, 2006.

Thus, the examiner's separate listing of the Reimelt patent on PTO-Form 892 as newly cited art is clearly in error. The examiner clearly noted and acknowledged this prior art reference of record in this case. Thus, for at least these reasons removal of the Reimelt reference as prior art is proper.

In addition, the Kruse patent 6,739,950 that the Examiner removed as prior art against the subject application by evidence that the subject application clearly predated the Kruse reference also cited the Reimelt patent '913 as prior art.

Still furthermore, Reimelt alternates the pressure from end to end - creating a shaking effect - reciprocating the particulate and debris inside the pipe, which causes damage to the pipes, and is substantially different from the subject invention.

MPEP section 706.04 states that full faith and credit should be given to the action of a previous examiner unless there is clear error in the previous action or knowledge of other prior art. The examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner in mere hopes of finding something. *Amgen Inc. v. Hoechst Marion Roussel, Inc.* 126 F. Supp. 2d 69, 139, 57 USPQ 2d 1449(D-Mass 2001). Thus, additionally for at least these reasons removal of the Reimelt reference as prior art is proper.

Applicant disagrees with the unsupported statement in regard to Kamiya "It is the examiner's position that the piping system is immediately ready to be returned to service, absent evidence to the contrary..." Clearly, Kamiya is only concerned with a "horizontal" leg, at most a single story, and not a multi-story structure as required by independent claim 10. Also, Kamiya does is not "introducing a nonliquid cleaning agent that includes an abrasive medium into the generated air..." into all the vertical and horizontal sections that are required by the "pressurized water supply piping system" of applicants claim 10.

Arguably, it might be "obvious to try" to test whether the "Kamiya" reference can be used in multi-story applications with pressurized vertical and horizontal water supply lines that include cleaning the pipes with a pressurized air source and "non-liquid...abrasive medium." However, Examiner is well aware that "obvious to try" is not

Appl No.: 10/649,288

Atty. Dkt.
PC-802

the standard for determining inventiveness. See also *In re Kaplan*, 789 F.2d at 1580, 229 U.S.P.Q. at 683, where the court held:

"In effect, what the Board did was to use a disclosure of appellants' own joint invention which had been incorporated in the Kaplan sole disclosure to show that their invention was but an obvious variation of Kaplan's claimed invention. That amounts to using an applicant's invention disclosure, which is not a 1-year time bar, as prior art against him. That is impermissible."

The mere fact that someone in the art can rearrange parts of references to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd.Pat.App. & Inter.1984).

There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vacck*, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).

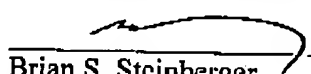
Applicant contends the references cannot be modified to incorporate the features of subject claims without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination.

In view of the foregoing considerations, it is respectfully urged that claims 10-14, 16, and 43-61 be allowed.

Alternatively, applicant requests that the amendment be entered and the previous final rejection be removed as being clearly premature and improper, and a new rejection be given in view of the facts that the previous office action erroneously refers to Reimelt as a newly found reference, and the examiner previously noted and acknowledged that Reimelt was previously cited by the Applicant and already made of record. In addition the Reimelt reference is no better than other references of record since the Examiner has removed the Kruse patent which cited the same Reimelt reference and was allowable in view of it. In addition, applicants' previous amendments DID NOT ADD NEW FEATURES TO the INDEPENDENT CLAIMS.

Applicant respectfully requests an additional interview with Examiners William Fletcher III and Supervisory Examiner Timothy Meeks, if the above amendment does not place the application in condition for allowance. Such action is respectfully requested.

Respectfully Submitted;



Brian S. Steinberger
Registration No. 36,423
101 Brevard Avenue
Cocoa, Florida 32922
Telephone: (321) 633-5080

Date 10/17/06